MARKED UP COPY OF CHANGES MADE:

IN THE SPECIFICATION:

Please amend page 1, lines 5-6 as follows, "This application [is a continuation-in-part of] claims priority from U.S. application number 60/106,510, filed on October 30, 1998."

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following arguments is respectfully requested.

Claims 1-18 have been deleted and replaced with new claims 19-40. Applicants reserve the right to prosecute any claim(s) canceled in response to the restriction requirement in a divisional application.

With respect to new claims 19-36, Applicants submit that the inclusion in these claims of the phrase "at a temperature above 72°F" does not involve any new matter. Specifically, Applicants submit that this newly added property of the claimed invention is inherently supported by the specification. According to MPEP 2163.07(a), to establish inherency, extrinsic evidence must make it clear that: (1) the missing descriptive matter is necessarily present in the thing described in the reference; and (2) it would be recognized by persons of ordinary skill in the art.

Applicants direct the Examiner's attention to page 13 of the specification that refers to *Eustoma* seeds of hybrid 3087 that were deposited with the American Type Culture Collection on October 30, 1998 and assigned A.T.C.C. Accession No. 203392. Because each of the parent plants of hybrid 3087 are inbred lines (see Example 1), every plant grown from the deposited seed should exhibit reduced apical dominance and continue to exhibit this trait at temperatures above 72°F. Additionally, as demonstrated by the attached declaration of Lynne Knosher pursuant to 37 C.F.R. §1.132 (Declaration), the plants of the claimed invention exhibit reduced apical dominance at temperatures above 72°F. This Declaration demonstrates that persons of ordinary skill in the art such as Ms. Knosher would recognize that the *Eustoma* plants of the present invention continue to exhibit reduced apical dominance at temperatures above 72°F. Thereupon, Applicants submit that new claims 19-36 do not contain any new matter.

Specification

Applicants have corrected the priority information on page 1, lines 4-5 to recite that the above-identified application claims priority from the provisional application filed on October 30, 1998.

Drawings

Applicants have noted the rejection of the drawings as being informal and the requirement of a petition to be filed for acceptance of the photographs as formal drawings. Applicants wish to hold the filing of such a petition in abeyance until receipt of notice from the Examiner of allowable subject matter.

Claim Rejections Under 35 U.S.C. Section 112, Second Paragraph

Claims 3, 10 and 13-18 and dependent claims 4-8 and 11 are rejected under 35 U.S.C. Section 112, second paragraph. Specifically, the Examiner stated that claims 3 and 10 were indefinite due to the phrase "or derivatives thereof." According to the Examiner it was not clear what the term "derivatives" was intended to modify.

With respect to claims 13-14, the Examiner stated that these claims were vague and indefinite in the recitation of "wherein the first and second parent *Eustoma* plant is the *Eustoma* plant of claims 1, 2 or 3." According to the Examiner, it was unclear how a hybrid can have the same male and female parent that is indicated by "and". Moreover, the Examiner stated that the verb did not accurately reflect the third person plural.

With respect to claim 15, the Examiner stated this claim was vague and indefinite due to the term "tested". According to the Examiner, it was unclear how the plant was to be tested and it appeared that the term "tested" had no antecedent basis in this claim.

With respect to claim 16, the Examiner stated that this claim was indefinite because it was incomplete. According to the Examiner, this claim did not contain any step indicating how

to recover or select a plant having an allele. In the Examiner's opinion it is unclear how a plant obtained by the process of claim 15 could contain only one allele or how all the hybrids could only contain one allele for reduced apical dominance.

Further with respect to claims 16-17, the Examiner stated that these claims were indefinite because it was not clear which plant of claim 15 was being referred to since many types of plants could be obtained.

With respect to claim 18, the Examiner said that because this claim recited seeds, plants and succeeding generations, that unless Applicants intended to claim a mixture of all these items that these should be listed in separate claims.

Claims 1-18 have been deleted and replaced with new claims 19-40. Applicants have taken the above recited rejections into consideration in drafting new claims 19-40. Therefore, Applicants submit that in view of the deletion of claims 1-18 and submission of new claims 19-40 that the above-identified rejections have been rendered moot and should be withdrawn.

Claim Rejections Under 35 U.S.C. Section 112, Second Paragraph

Claims 1-11 and 13-18 are rejected under 35 U.S.C. Section 112, first paragraph as not being enabled.

The Examiner indicated that the deposit of seeds for 3087 satisfied the deposit requirement for previous claims 1-2, 9, and 15-18. Submitted herewith is a declaration of the undersigned attorney, Lisa V. Mueller, which indicates that 2500 seeds of 3087 were deposited under the Budapest Treaty and that all restrictions on this deposit will be irrevocably and without restriction or condition, released to the public upon the issuance of the patent based upon the above-identified application.

The Examiner also indicated that the deposit of hybrid seed 3087 did not meet the deposit requirements for any claims to a plant containing derivatives of pedigreed line 752. Applicants

wish to hold the deposit of this seed in abeyance until receipt of notification from the Examiner of allowable subject matter. Applicants have added new claims 39 and 40 that relate to pedigreed line 752. Applicants will amend these claims to recite to the ATCC deposit number for pedigreed line 752 once this deposit is made.

Claims 16-17 are rejected under 35 U.S.C. Section 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, the Examiner stated that the specification provided no guidance as to how to recover hybrid *Eustoma* seed having a genome that contained an allele for reduced apical dominance. Specifically, the Examiner stated that "[T]hus, if the F_1 from claim 15 already contains an allele for reduced apical dominance, the process in claim 16 would produce progeny, 25% which would have allele and 25% which contained two alleles at the same locus. Those progeny containing only one allele, i.e. an allele, would not exhibit reduced apical dominance, due to the recessive nature of the trait. In contrast, the claims are drawn to *Eustoma* plants containing an allele for reduced apical dominance."

Claims 16-17 have been deleted. Applicants have taken this rejection into consideration in drafting new claims 19-40. Therefore, Applicants submit that in view of the deletion of claims 1-18 and the submission of new claims 19-40 that the above-identified rejection has been rendered moot and should be withdrawn.

Rejection of Claims Under 35 U.S.C. Section 102(b) and 35 U.S.C. Section 103(a) as being Obvious

Claims 1, 4-8 and 13-14 are rejected under 35 U.S.C. Section 102(b) as being anticipated by Griesbach et al. Claims 1-11 and 13-18 are rejected under 35 U.S.C. §103(a) as obvious over Griesbach et al. Claims 1-11 and 13-14 have been deleted. This rejection will now be addressed with respect to new claims 19-36.

New claims 19-36 generally refer to *Eustoma* plants and seeds which produce plants having reduced apical dominance and that exhibit the trait of reduced apical dominance at a temperature above 72°F as well as to methods for making said plants and seeds. Applicants submit that while Griesbach et al. disclose *Eustoma* plants having basal branching, that the basal branching of the plants described by Griesbach et al. is sensitive to temperatures above 22°C (72°F). This is described on page 790, in the third column, where Griesbach et al. state that "[U]nder cool conditions, not higher than 16°C at night, plants flowered in 150 days with two to four basal branches, and the total number of flowers was between 30 and 50. At temperatures higher than 22°C at night, plants flowered in 90 days **with no basal branches** " (emphasis added).

In contrast, the basal branching exhibited by the reduced apical dominant plants of the present invention is not temperature sensitive. In fact, the plants of the present invention continue to exhibit basal branching at temperatures above 72°F. Applicants specifically refer to the enclosed Declaration. In this Declaration, Lynne Knosher, one of the inventors of the present invention, describes the results of a greenhouse trial involving *Eustoma* plants of the present invention. As demonstrated in Paragraph 5 of the Declaration, seedlings of the present invention subjected to temperatures of about 90°F exhibited the reduced apical dominant phenotype.

Therefore, because Griesbach et al. does not specifically teach, disclose or suggest *Eustoma* plants that exhibit reduced apical dominance at temperatures above 72°F, Applicants submit that new claims 19-38 are not anticipated under 35 U.S.C. Section 102(b) nor rendered obvious under 35 U.S.C. Section 103(a).

In view of the aforementioned amendments and arguments, Applicants submit that the claims are now in condition for allowance.

If any additional fees are incurred as a result of the filing of this paper, authorization is given to charge deposit account number 07-0181.

Respectfully submitted,

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